

**REMARKS**

Claims 7-8 and 11-12 are pending in this application. By this Amendment, claims 1 and 2 are canceled and claims 7 and 8 are amended. The amendments to claims 7 and 8 remove members of the originally claimed Markush groups. Thus, no new matter is added. In view of the amendments and the foregoing remarks, reconsideration and allowance are respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

**I. Rejection under §112, second paragraph**

The Office Action rejects claims 1-2, 7-8 and 12-13 under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejections.

**A. Monomer**

The Office Action alleges that the scope of claims 1, 2, 7 and 8 is unclear. In particular, the Office Action states that the claims do not clearly indicate whether the monomers are acrylates, methacrylates, or both.

Claims 1 and 2 are canceled, thus rendering moot this aspect of the rejection. Amended claims 7 and 8 feature monofunctional monomers that include both acrylate monomer and methacrylate monomer. Thus claims 7 and 8, and claims 12 and 13 dependent

thereon respectively, satisfy the requirements of 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

**B. Isobonyl methacrylate**

The Office Action asserts that "isobonyl" methacrylate featured in claims 1, 7 and 8 is unclear. Claim 1 is canceled and amended claims 7 and 8 do not feature isobonyl methacrylate, thus rendering this rejection moot. Applicants respectfully request reconsideration and withdrawal of this rejection.

**II. Rejection under §102**

The Office Action rejects claims 1-2 under 35 U.S.C. §102(b) over U.S. Patent No. 5,644,010 to Kurihashi et al. The Amendment cancels claims 1-2, thus rendering moot this rejection. Applicants respectfully request reconsideration and withdrawal of this rejection.

**III. Rejections under §103**

**A. Claims 1-2**

The Office Action rejects claims 1-2 under 35 U.S.C. §103(a), separately over GB 2318356 in view of U.S. Patent No. 6,359,025 to Snowwhite et al. ("Snowwhite ") and U.S. Patent No. 6,048,653 to Ochiai et al. ("Ochiai"); and over EP 465039 in view of Snowwhite and Ochiai.

The Amendment cancels claims 1-2, thus rendering the rejections moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections.

**B. Claims 7-8 and 12-13**

**1. EP 465039, Snowwhite, Ochiai, and Asai**

The Office Action rejects claims 7-8 and 12-13 under 35 U.S.C. §103(a) over EP 465039 in view of Snowwhite, Ochiai and U.S. Patent No. 5,446,082 to Asai et al. ("Asai"). Applicants respectfully traverse this rejection.

EP 465039 describes an ink composition that includes colorant, monofunctional monomer such as isobornyl acrylate and difunctional monomer such as hexanediol di(meth)acrylate (see, col. 2, line 57 - col. 3, line 7; col. 3, lines 28-28). The Office Action recognizes that EP 465039 does not teach isobornyl methacrylate and nonanediol diacrylate as originally claimed but relies on Snowwhite for teaching the equivalence and interchangeability of isobornyl acrylate and isobornyl methacrylate. The Office Action further states that nonanediol diacrylate and hexanediol diacrylate are homologs and cites Ochiai for additional support teaching their equivalence and interchangeability.

Amended claims 7 and 8 are directed to an image made with an ink comprising at least a colorant, and a resin liquid containing at least a photoreactive monofunctional monomer and/or at least a photoreactive bifunctional monomer, wherein said monofunctional monomer comprises hydroxybutyl acrylate monomer or diethyleneglycol methacrylate monomer, and said bifunctional monomer comprises diethyleneglycol diacrylate monomer. Amended claims 7 and 8 do not recite isobornyl methacrylate and nonanediol diacrylate as featured monomers in the claimed ink composition. Moreover EP 465039, Snowwhite, Ochiai and Asai do not teach or suggest the use of hydroxybutyl acrylate, diethyleneglycol methacrylate and diethyleneglycol dicarylate as claimed.

For at least this reason, the above cited references would not have rendered claims 7 and 8 obvious to one of ordinary skill in the art. Claims 12 and 13 depend from claims 7 and 8 respectively and also would have not been rendered obvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

## **2. GB2318356, Snowwhite, Ochiai, and Asai**

The Office Action rejects claims 7-8 and 12-13 under 35 U.S.C. §103(a) over GB2318356, in view of Snowwhite, Ochiai and Asai. Applicants respectfully traverse this rejection.

GB2318356 describes an ink composition that includes a coloring agent and one or more polymerizable monomers such as isobornyl acrylate and hexanediol di(meth)acrylate. Analogous to the above rejection, the Office Action relies on Snowwhite, Ochiai and Asai to teach the equivalence and interchangeability of isobornyl acrylate and methacrylate, and nonanediol diacrylate and hexanediol diacrylate. However, amended claims 7 and 8 do not recite isobornyl methacrylate and nonanediol diacrylate as featured monomers in the claimed ink composition and GB2318356, Snowwhite, Ochiai and Asai do not teach or suggest the use of hydroxybutyl acrylate, diethyleneglycol methacrylate and diethyleneglycol dicarylate in an ink composition as claimed.

For at least this reason, the above cited references would not have rendered claims 7 and 8 obvious to one of ordinary skill in the art. Claims 12 and 13 depend from claims 7 and 8 respectively and also would have not been rendered obvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

**3. EP 465039, Ito, Snowwhite and Ochiai**

The Office Action rejects claims 7-8 under 35 U.S.C. §103(a) over EP 465039 in view of U.S. Patent No. 5,912,085 to Ito et al. ("Ito"), Snowwhite and Ochiai. Applicants respectfully traverse this rejection.

As detailed above, EP 465039, Snowwhite and Ochiai do not teach or suggest the use of hydroxybutyl acrylate, diethyleneglycol methacrylate and diethyleneglycol dicarylate as claimed. Ito contains nothing to remedy these deficiencies. Moreover, the Office Action does not rely on Ito to teach or suggest these deficiencies. EP 465039, Ito, Snowwhite and Ochiai do not teach or suggest the use of hydroxybutyl acrylate, diethyleneglycol methacrylate and diethyleneglycol dicarylate in an ink composition as claimed.

For at least this reason, the above cited references would not have rendered claims 7 and 8 obvious to one of ordinary skill in the art. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

**4. EP 465039, Ito, Snowwhite, Ochiai and Asai**

The Office Action rejects claims 12-13 under 35 U.S.C. §103(a) over EP 465039, Ito, Snowwhite, Ochiai and Asai. Applicants respectfully traverse this rejection.

Claims 12 and 13 depend from claims 7 and 8 respectively. As detailed above, EP 465039, Ito, Snowwhite and Ochiai do not teach or suggest the use of hydroxybutyl acrylate, diethyleneglycol methacrylate and diethyleneglycol dicarylate, as featured in claims 7 and 8. However, Asai does not fill these deficiencies. Moreover, the Office Action does not rely on Asai to teach or suggest these monomer compounds. Thus, EP 465039, Ito, Snowwhite, Ochiai and do not teach or suggest the use of hydroxybutyl acrylate, diethyleneglycol methacrylate and diethyleneglycol dicarylate in an ink composition as featured in claims 12 and 13.

For at least this reason, the above cited references would not have rendered claims 12 and 13 obvious to one of ordinary skill in the art. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 7-8 and 12-13 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

H. James Voeller  
Registration No. 48,015

Joel S. Armstrong  
Registration No. 36,430

JAO:HJV/tea

Date: August 28, 2003

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

|                                                                                                                                                                    |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>DEPOSIT ACCOUNT USE<br/>AUTHORIZATION<br/>Please grant any extension<br/>necessary for entry;<br/>Charge any fee due to our<br/>Deposit Account No. 15-0461</p> |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------|